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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/990,593

11/23/2001

Chin Lay David Yeo

2071

7590 03/23/2007  
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EXAMINER

NELSON, FREDA ANN

ART UNIT

PAPER NUMBER

3628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/23/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/990,593

Applicant(s)

YEO ET AL.

Examiner

Freda A. Nelson

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☒ Claim(s) 1, 3 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This is in response to a letter for a patent filed November 23, 2001 in which claims 1-28 were presented for examination. Claims 1-28 are currently pending.

#### ***Claim Objections***

1. Claims 1, 3, and 17 are objected to because of the following informalities:

Claim 1, line 4, delete "of" after "characteristic";

Claims 3 and 17 are incomplete.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 3-4, 15, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, the examiner is unable to determine by the claim language "the service profile can possess" if the service profile actually possesses a particular character. Because the claim language does not positively recite that the service profile possesses a particular characteristic, the examiner takes the position that service profile does not possess a particular characteristic.

Claims 1 and 15, respectively, recite the limitation "the valuation" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the number" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the cumulative" in lines 9-10. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the worth" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

As per claims 3 and 17, the examiner is unable to determine what the applicant is claiming because the claim limitation is incomplete.

Claim 4 recites the limitation "the level" in line 3. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-15, 17-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krespi (US PG Pub. 2001/0032196), in view of Parry et al. (US PG Pub. 2003/0041005).

As per claims 1 and 15, Krespi discloses a method for the valuation of services (goods), the method comprising the steps of:

generating at least one service (goods) profile for a service (good), a service (good) profile defining a combination of any of a plurality of profile attributes, wherein each profile attribute represents a particular characteristic of that the service (goods) profile can possess (paragraph [0018]; FIG. 3);

generating a price for each service (goods) profile (paragraph [0017]);  
selecting one or more service (goods) profiles by the user (paragraphs [0020]-[0021]);  
creating a selected profiles list, the selected profiles list containing the service (goods) profiles selected by the user (paragraph [0022]); and  
updating the price for each service (goods) profile (paragraph [0017],[0022])

Krespi discloses generating at least one service (goods) profile for a service (good), a service (good) profile defining a combination of any of a plurality of profile attributes, wherein each profile attribute represents a particular characteristic of that the service (goods) profile can possess (paragraph [0118]). Information as to a residual services quantification is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See : *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps

Art Unit: 3628

are to be performed. The method steps, disclosed would be performed the same regardless of the residual services profile. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the user with a services (goods) profile because the residual services quantification does not functionally relate to the steps in the method claimed.

Krespi does not explicitly disclose the valuation of services.

However, Parry et al. disclose an on-line auction (such as an Internet auction), where services are the subject of such auction; and more specifically, the services have a highly variable valuation (e.g., a "time-sensitive" value); and a common rating scale is provided so that the value (and, in particular, the time-sensitive nature of the value) of such services may be specified. Thus, this gives a common unit of measurement for perceived valuation of a service (paragraph [0029]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Krespi to include the feature of Parry et al. in order to provide the valuation of goods and services.

Claims 2 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krespi (US PG Pub. 2001/0032196), in view of Parry et al. (US PG Pub. 2003/0041005), still in further view of Sklarz et al. (US PG Pub. 2002/0087389).

As per claims 2 and 16, Krespi et al. do not expressly disclose accepting from the user a preference rank for each of the service profile in the selected profiles list.

However, Sklarz et al. disclose as an example, a buyer without children may wish to be remote from K-12 schools, and could assign proximity to K-12 schools a lower weight than the average buyer; and the properties identified by the appraisal engine in "buyer mode" can be rank ordered by appraisal score or by predicted sales price (paragraph [0256]).

As per claims 3-14 and 17-28, Krespi discloses generating at least one service (goods) profile for a service (good), a service (good) profile defining a combination of any of a plurality of profile attributes, wherein each profile attribute represents a particular characteristic of that the service (goods) profile can possess (paragraph [0118]). Information as to a residual services quantification is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See : *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed would be performed the same regardless of the residual services profile. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the user with a services (goods) profile

Art Unit: 3628

because the residual services quantification does not functionally relate to the steps in the method claimed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Krespi et al. to include the feature of Skarlz et al. in order to provide the user the ability to apply weights to features by importance.

### ***Conclusion***

4. The examiner has cited prior art of interest, for example:

1) Boyden et al. (US PG Pub. 2003/0036964), which disclose a method and system of valuating used vehicles for sale at an electronic auction using a computer.

2) Halbout et al. (US Patent Number 6,978,257), which disclose a system and method for measuring and pricing midrange computer server outsourcing services.

3) Hunt (US Patent Number 5,794,220), which disclose a method and means for ranking and pricing items.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

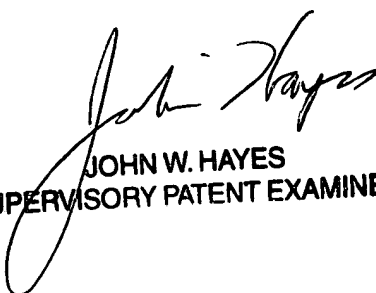


Art Unit: 3628

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FAN 03/16/2007



JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER